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PATENT
Docket No.: RUANA-002 307

#Reg for Refund

7/16/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 3612

Examiner: Hilary L. Gutman

Serial No.: 09/877,409

Filed: June 7, 2001

In re Application of: Bruce M. Ruana

For: RAILING ADVERTISING—SURFACE, SYSTEM AND METHOD

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail, in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 12, 2003

Signed

Carol Stanley

Carol Stanley

REQUEST FOR REFUND OF PETITION FEE

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

\$1,650.00

Sir:

A Request for Non-publication was filed in the United States Patent and Trademark Office for United States patent application serial No. 09/877,409 on June 7, 2001. A PCT Request was filed in the PCT Receiving Office in the United States Patent and Trademark Office for the above-identified patent application on June 5, 2002. A paper captioned "Transmittal Letter" and addressed to the Director was filed in the United States Patent and Trademark Office on the same day as the PCT Request. This paper identified the pending United States patent application serial No. 09/877,409 and notified the Director that the PCT Request was being filed. This paper was, therefore, filed in the PTO within 45 days of the filing of the PCT Request.

Pursuant to 37 C.F.R § 1.213(c), a Request to Rescind the Non-Publication request was filed in the United States Patent and Trademark Office for the above-identified patent application on June 5, 2002, within 45 days of the filing of the PCT Request.

The undersigned spoke with an attorney in the Office of Patent Law Administration (OPLA) who indicated that the PTO takes the position that it does not consider the filing of such Transmittal Letter relating to the PCT Request for the above-identified patent application in the Receiving Office of the United States Patent and Trademark Office to constitute notice of such filing because of the provisions of 37 C.F.R. §1.4(b), relating to the filing of paper in the PTO. The undersigned believes that this position taken by the PTO is legally incorrect, but was required by the obligation to act on behalf of the client and therefore filed a completed Form PTO/SB/64a(05-03) to preserve the rights of the client in the application. This form contains a statement that the above-identified application is abandoned and petitions for its revival.

It is respectfully asserted that the above-identified patent application has never been abandoned under the provisions of 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R §1.213(c) and it is hereby requested that the petition fee be refunded. It is also respectfully requested that the PTO acknowledge that the above-identified patent application has never been abandoned under the provisions of 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R §1.213(c).

DISCUSSION

The Notice to the Director Was Given In A Timely Manner

In addition to rescinding any outstanding Request for Non-Publication, the statute, 35 U.S.C. § 122 (b)(2)(B)(iii), requires that the applicant notify the Director of any foreign filing within 45 days thereafter. The statute states:

An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

As is plain from reading the above-quoted statute, it does not specify the manner in which such notice of foreign filing is to be given to the Director.

Similarly, the Rule, 37 C.F.R. §1.213(c), merely provides that notice of a foreign filing be given to the Director. Like the statute, it also fails to specify how such notice is to be given or that such notice even be placed in the file of the United States patent application from which priority is sought. Specifically, 37 C.F.R. §1.213(c) states:

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. §122 (b)(2)(B)(iii)).

Note that while the rulemaker was capable of identifying the underlying U.S. application and did so by providing in the rule that "[t]he failure to timely notify the Office of the filing of such foreign or international application *shall result in abandonment of the application in which the nonpublication request was submitted* [emphasis added]", the rulemaker failed to articulate any requirement that such notice be given *in that application* as opposed to being given in some other manner.

Finally, neither the Notice of Proposed Rulemaking, 65 FR 17946, 17957 (2000), nor the final rulemaking notice in the Official Gazette of October 10, 2000 specify or imply any requirement that the statutory notice to the Director be captioned as or even placed in the file of the United States patent application from which priority is sought.

It is respectfully asserted that the filing of a PCT Request for the above-identified patent application in the PCT Receiving Office of the United States Patent and Trademark Office itself serves to give notice to the Director of the filing of the PCT application as required by both 35 U.S.C. § 122 (b)(2)(B)(iii) and 37 C.F.R. § 1.213(c). 37 C.F.R. § 1.412(a) provides that the United States Patent and Trademark Office is a Receiving Office for the Patent Cooperation Treaty. It is in fact respectfully asserted that the paper addressed to the Director, entitled "Transmittal Letter", accompanying such PCT Request filed in the Receiving Office of the United States Patent and Trademark Office is the ultimate act of giving notice to the Director of such filing. It is respectfully submitted that the filing of any paper in the United States Patent and Trademark Office constitutes actual notice to the Director of the filing of that paper. In this case, the paper identified a pending United States patent application and gave notice to the Director that a PCT Request was being filed claiming priority to that application. It is thus respectfully asserted that the 45-day notice requirement of both 35 U.S.C. § 122 (b)(2)(B)(iii) and 37 C.F.R. § 1.213(c) have been satisfied with respect to the present application.

It is respectfully submitted that the position taken by the PTO that the required notice has not been given to the Director in this matter is contrary to applicable law and rules and cannot be sustained. In the present case, notice was given to the Director in a paper (captioned as a Transmittal Letter) that 1) identified a pending United States application, and 2) notified the Director that a PCT application claiming priority to that pending United States Application was being filed in the U.S. Receiving Office of the PTO. This paper was filed on the same day as the PCT Request and thus was filed within 45 days of the PCT Request as required by 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R. §1.213(c).

If the PTO intended such a requirement to be part of 37 C.F.R. §21(c), it certainly kept such intention to itself and completely failed to notify users of the PTO that it intended such an interpretation of the statute and the rule. The only evidence of a requirement that the notice of foreign filing be given to the Director in a paper that is captioned as belonging to the United States application from which priority is claimed is the oral assertion of an attorney at OPLA that such a requirement exists. For that reason alone, the Director should exercise his authority under 37 C.F.R. §1.183 to suspend operation of §1.4(b). It is submitted that this is an extraordinary situation where justice requires suspension of the rules. It is understood that this situation is widespread and has arisen partly because the PTO has failed to articulate its interpretation of what constitutes foreign-filing notice.

As noted above, neither 35 U.S.C. §122 (b)(2)(B)(iii) nor 37 C.F.R. §1.213(c) can be interpreted to require that the mandated notice to the Director of foreign filing is a "paper to be filed in an application" (meaning the United States application from which priority is claimed) within the meaning of 37 C.F.R. §1.4(b). Both the statute and the rule merely require that the Director be given notice of the foreign filing. The Director has been given such notice within the 45-day period specified by 35 U.S.C. §122 (b)(2)(B)(iii) and 37 C.F.R. §1.213(c). It is respectfully asserted that any assertion to the contrary would be disingenuous.

It is respectfully asserted that it has been established that the notice required by 35 U.S.C. § 122 (b)(2)(B)(iii) was given to the Director by filing the paper entitled "Transmittal Letter" accompanying the PCT Request. It is therefore respectfully requested the petition fee of \$1,300.00 be refunded. It is also respectfully requested that the PTO acknowledge that the above-identified patent application has never been abandoned under the provisions of 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R §1.213(c).

In the event that the PTO disagrees with the position set forth herein, it is respectfully requested that the Director should exercise his authority under 37 C.F.R. §1.183 to suspend operation of 37 C.F.R. §1.4(b) in this instance. It is submitted that this is an extraordinary situation where justice requires suspension of the rules.

It is understood that this situation is widespread. It is respectfully urged that the PTO is partly to blame for this situation by promoting the use of its prior form that did not contain an explicit notice of foreign filing. The PTO has tacitly admitted this omission by promulgating a new form incorporating the notice. Situations like the instant one, where a separate paper notifying the Director that a foreign application has been filed, has arisen partly because the PTO has failed to articulate to its users its interpretation of what constitutes foreign-filing notice to the Director.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.



Kenneth D' Alessandro
Reg. No.: 29,144

Dated: June 12, 2003

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